



PATENT
Attorney Docket No. 5725.0905-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Valérie DE LA POTERIE et al.)	Group Art Unit: 1617
)	
Application No.: 09/881,097)	Examiner: Lamm, Marina
)	
Filed: June 15, 2001)	
)	
For: FILM-FORMING COSMETIC)	Confirmation No.: 7312
COMPOSITION)	
)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated September 7, 2007. A request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. Status of Rejections

In response to the Appeal Brief filed November 20, 2006 ("the Appeal Brief"), the Examiner in the Answer has maintained the rejection of claims 1-10, 12, 13, 15-18, 20-56, and 59 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Examiner's Answer at page 3.

II. Response to Examiner's Arguments in the Answer

In response to the Examiner's § 112 rejection, Appellants maintain that the Examiner has not in the present case met the burden needed to support the written description rejection. Appellants believe that the Examiner's positions have already been addressed in large part in the Appeal Brief, and provide a few additional reasons below.

According to the Examiner

The instant specification does not provide **sufficient information** and **guidance** for one skilled in the art as to what members of the genus semi-crystalline compounds having the specified transition temperature and water-solubility, other than polycaprolactones, could be used in the instant invention. Without a correlation between structure and function, the claim does little more than define the claimed invention by function. That is not sufficient to satisfy the written description requirement.

Examiner's Answer at page 5 (emphasis in original) (citing *University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 U.S.P.Q.2d 1398, 1406 (Fed. Cir. 1997) ("definition by function . . . does not suffice to define the genus because it is only an indication of what the genus does, rather than what it is").

Appellants reiterate, as they have done throughout the prosecution of this case, that the Examiner has not set forth express findings to support the written description rejection. Appellants note, moreover, that the very case that the Examiner cites to

support the Examiner's position of a lack of written description states that an adequate written description "requires a precise definition, such as by structure, formula, chemical name, **or physical properties.**" *Regents of the Univ. of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404 (Fed. Cir. 1997)(quotation omitted)(emphasis added). Such a precise definition is in fact provided in the present application, in the form of physical properties disclosed in the specification and recited in the claims. Specifically, the claimed "at least one thermal transition agent" is defined by 1) its semi-crystalline nature, 2) its transition temperature range, and 3) its lack of water solubility below the transition temperature. The Examiner has not explained why the disclosure of at least these three physical properties - like the physical properties held by the Federal Circuit in *Regents of the Univ. of California* as being sufficient to provide a precise definition - are not adequate to provide a written description of the claimed invention.

Appellants also note that the Examiner has incorrectly quoted the text of that opinion. The cited portion of the *Regents of the Univ. of California* opinion reads "[a] definition by function, as we have previously indicated does not suffice to define the **genus** because it is only an indication of what the **gene** does, rather than what it is." 119 F.3d. at 1568, 43 U.S.P.Q.2d at 1406 (emphasis added). The Examiner's citation error on page 5 of the Examiner's Answer uses the term "genus" as opposed to the term "gene." ("[D]efinition by function . . . does not suffice to define the **genus** because it is only an indication of what the **genus** does." (emphasis added)). This citation error is not insignificant considering that the claimed subject matter does not pertain to a gene. Furthermore, the case even points out a distinction between "claims involving chemical

materials” wherein “generic formulae usually indicate with specificity what the generic claims encompass,” and “claims to genetic material” wherein “a generic statement . . . is not an adequate description of the claimed genus.” *Id.* Again, Appellants submit that the Examiner has not explained why the disclosure of at least the three physical properties discussed above are inadequate to provide a written description of the claimed invention.

The Examiner goes on to cite the Federal Circuit’s opinion in *Enzo Biochem, Inc. v. Gen-Probe*, 323 F.3d 956, 63 U.S.P.Q.2d 1618 (Fed. Cir. 2002) where the Federal Circuit “stated that the legal standard for sufficient written description is met by ‘showing that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics . . . i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.’” Examiner’s Answer at page 6. The very section cited by the Examiner, however, makes clear that physical properties, as disclosed in the instant case, are sufficient identifying characteristics for showing that an invention is complete for written description purposes.

The Examiner also mentions that “*Enzo* adopted the USPTO’s Written Description Guidelines that a functional description is adequate when it is coupled with a disclosed correlation between the function and structure that is sufficiently known or disclosed.” Examiner’s Answer at page 6. These Guidelines, however, do not intimate that this is the only form of an adequate written description. To the contrary, these Guidelines clearly set forth that “[f]actors to be considered in determining whether there

is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, **physical and/or chemical properties, functional characteristics alone** or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention." Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1, "Written Description" Requirement, 66 Fed. Reg. 1099, 1106 (Jan. 5, 2001) (emphasis added).

For at least these reasons and the reasons of record, Appellants submit the Examiner's written description rejection is improper.

III. Conclusion

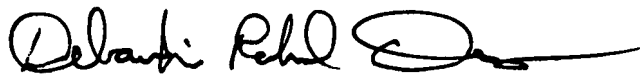
Accordingly, Appellants respectfully request that the rejection be reversed and withdrawn.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, L.L.P.

Dated: November 7, 2007

By: 

Debarshi Rahul Das

Reg. No. 55,100